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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/998,124	12/24/97	REPP	R DON02-P-684
EXAMINER			

PM31/0702
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	4

3623

DATE MAILED:
07/02/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 12/24/97

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 (THREE) month(s), or ~~thirty days~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 2-24 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 2-24 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 3
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

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Claims 2-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 2, lines 15-18, the phraseology is not readily understood by the Examiner. In claim 2, line 1, it is not readily apparent to the Examiner if the applicant is claiming a hinged window assembly or a hinged window assembly in combination with a vehicle. In claim 17, lines 1-2, the applicant clearly and positively recites a vehicle. If the applicant intends to claim the combination then the applicant must clearly and positively recite the vehicle in the preamble.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-24 are further rejected under the judicially created doctrine of double patenting over claims 1-71 of U. S. Patent No. 5,551,197 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a hinged window assembly comprising a glass sheet, an opaque coating on the glass

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sheet, a hinge mounted to an adhesive which is mounted to the opaque surface such that the hinge is hidden from view.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 2-24 are further rejected under the judicially created doctrine of double patenting over claims 1-25 of U. S. Patent No. 5,704,173 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a hinged window assembly comprising a glass sheet, an opaque coating on the glass sheet, a hinge mounted to an adhesive which is mounted to the opaque surface such that the hinge is hidden from view.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-24 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Aldrich. Aldrich discloses a hinged panel assembly comprising a panel having an opaque surface (column 2, lines 52-64) on an inner surface, an adhesive material (column 3, lines 33-35) mounting a block which attaches a metal hinge assembly thereto. Aldrich fails to recite the panel being 250 square inches, the adhesive being moisture/thermally/chemically activated, the bonding area being between four and fifty square inches, and the bonding thickness being 1, 5, or 25 microns. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the hinged panel assembly of Aldrich being 250 square inches, the adhesive being moisture/thermally/chemically activated, the bonding area being between four and fifty square inches, and the bonding thickness being 1, 5, or 25 microns since it would have been a matter of design choice to modify Aldrich by adjusting the size of the panel, having activated adhesive, and providing a specific surface area and thickness of the bond since the applicant has not disclosed that these design modifications solves any stated problem or is for any particular purpose and it appears that Aldrich would perform equally well with the design parameters being adjusted.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. patents to Fisher et al., Blomgren et al., Sykes, and George et al. disclose elements similar to that of the applicants invention.

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Any inquiry concerning this communication should be directed to Jerry Redman at telephone number (703) 308-2168.


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